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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,030	11/04/2003	Thomas L. Kelly	KES-0004	6735
23413	7590	07/25/2007		
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER DREIDAME, HUNTER M	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/702,030	KELLY, THOMAS L.	
	Examiner	Art Unit	
	Hunter M. Dreidame	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of applicant's amendment received 23 April 2007, Applicant's Remarks have been carefully considered but are not deemed persuasive to overcome the rejections of the previous office action. Therefore, the rejection of pending claims 1-14 has been reiterated in this final office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1-6, and 8-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Carr, III et al. US Patent 6,502,360.

Regarding claim 1, Carr, III et al. discloses an apparatus that can be assembled by the method of reducing damage in a roof membrane caused by hail/fastener impact comprising: locating a fastener (16 fig 1) in a roof construction; positioning an energy absorbing material (20 fig 1) to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by said material; and affixing (18 fig 1, the asphalt material 18 affixes the energy absorbing material to the fasteners) said material to said fastener.

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Regarding claim 2, Carr, III et al. discloses an apparatus that can be assembled by the method of reducing roof membrane damage from hail/fastener contact as claimed in Claim 1 wherein said affixing is by adhering (18 fig 1).

Regarding claim 3, Carr, III et al. discloses an apparatus that can be assembled by the method of reducing roof membrane damage from hail/fastener contact as claimed in Claim 2 wherein said adhering is by a self stick adhesive (18 fig 1) applied to said energy absorbing material. It is noted that the asphalt layer would act as an adhesive to bond layers 22 and 24 to layer 14 in figure 1.

Regarding claim 4, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics comprising: a roof substrate (12 fig 1) having one or more layers of material; at least one fastener (16 fig 1) exposed at a top surface of said substrate; a dedicated energy absorbing material (20 fig 1) positioned to discretely cover each individual fastener of said at least one fasteners; and a roof waterproofing membrane (22 fig 1) positioned atop all foregoing elements.

Regarding claim 5, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said one or more layers of material includes insulation (12 fig 1). It is noted that any of the layers can be considered an insulating layer because the layers would provide as some form of insulation.

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Regarding claim 6, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said energy absorbing material is cover tape (20 fig 1). It is noted that the cover tape 20 is the combination of layers 22 and 24 in figure 1.

Regarding claim 8, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 6 wherein said cover tape is ethylene propylene diene monomer (22 fig 1, column 2 lines 58-59).

Regarding claim 9, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 6 wherein said cover tape is self-adhesive tape (20 fig 1). It is noted that the cover tape adheres itself to the asphalt layer 18 fig 1.

Regarding claim 10, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said energy absorbing material is two layers (22 and 24 fig 1).

Regarding claim 11, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 10 wherein said two

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layers comprise a first layer (24 fig 1) covering a fastener (16 fig 1) and a second layer (22 fig 1) covering the first layer and a washer of the fastener.

Regarding claim 12, Carr, III et al. discloses an apparatus that can be assembled by the method for reducing roof membrane damage from hail/fastener contact as claimed in Claim 1 wherein said energy absorbing material (20 fig 1) is installed on top of the roofing membrane (12 fig 1) in an area directly over and underlying fastener (16 fig 1).

Regarding claim 13, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics comprising: a roof substrate (12 fig 1) having one or more layers of material; at least one fastener (16 fig 1) exposed at a top surface of said substrate; a roof waterproofing membrane (22 fig 1) positioned over said at least one fastener; and a dedicated energy absorbing material (20 fig 1) positioned atop all foregoing elements.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr, III et al. US Patent 6,502,360.

Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said energy absorbing material is a self-sticking cover tape composed of cured EPDM (22 fig1); however, Carr, III et al. does not disclose an EPDM with a butyl gum rubber bottom. The applicant's specification discloses in the second paragraph of the detailed description the following: "The energy absorbing material may comprise ethylene propylene diene monomer (EPDM), butyl rubber, EPDM with a butyl gum rubber bottom or other flowable material as a combination including at least one of the foregoing, and in one embodiment is affixed to fastener..." It would have been obvious to one of ordinary skill in the art at the time the invention was made as a matter of design choice to use an EPDM or butyl rubber or EPDM with a butyl gum rubber bottom or other flowable material as a combination including at least one of the foregoing to be used in a roofing system because, as stated above, applicant makes an admission that these items are interchangeable.

Regarding claim 14, Carr, III, et al. disclose the roof system as claimed in claim 1. Carr, III, et al. do not disclose a roof system wherein at least one layer of said energy absorbing material is dimensioned to only cover a fastener head of said at least one fastener. It would have been a matter of obvious design choice to make the energy absorbing material smaller, as such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Response to Arguments

Applicant's arguments filed 23 April 2007 have been fully considered but they are not persuasive.

Applicant argues that the prior art of record does not show the new limitation of positioning an energy absorbing material *to discretely cover each individual fastener* of said fasteners whereby said fastener is completely covered by said material. As it is the Examiner's duty to give all claims the broadest possible interpretation, the Examiner has interpreted the amended material in that each fastener is discretely covered because each fastener is covered by its own portion of energy absorbing material.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter M. Dreidame whose telephone number is (571)272-5177. The examiner can normally be reached on Monday - Friday 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Hunter M. Dreidame, Patent Examiner
July 20, 2007



Carl D. Friedman
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Group 3600